

REMARKS

By this Amendment, Applicants amend claims 5 and 7-16 to more properly define the present invention and cancel claims 1-4 without any prejudice or disclaimer to the subject matter thereof. Applicants also add new claims 25-28 to address other aspects of the present invention. Claims 5 and 7-28 are pending, with claims 17-24 withdrawn from consideration.

In the Office Action, the Examiner rejected claims 5 and 7-16 under 35 U.S.C. § 112, second paragraph; rejected claims 5, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,677,894 to Sheynblat et al. ("Sheynblat") in view of U.S. Patent No. 6,058,311 to Tsukagoshi ("Tsukagoshi"); rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of U.S. Patent No. 6,072,875 to Tsudik ("Tsudik"); rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of U.S. Patent No. 6,636,489 to Fingerhut ("Fingerhut"); and rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of Fingerhut and U.S. Patent No. 6,311,185 to Markowitz et al. ("Markowitz").¹ Applicants respectfully traverse all of the Examiner's rejections.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

I. Regarding the rejection of claims 5 and 7-16 under 35 U.S.C. § 112

Applicants respectfully traverse the Examiner's rejection of claims 5 and 7-16 under 35 U.S.C. § 112 for lack of clarity and for insufficient antecedent basis. However, to expedite prosecution, Applicants have amended claims 5 and 7-16 to more even clearly define the present invention and to add even more sufficient antecedent basis. Accordingly, Applicants respectfully request withdrawal of the Section 112 rejection of claims 5 and 7-16.

II. Regarding the rejection of claims 5, 9-11, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5, 9-11, and 14-16 as being unpatentable over Sheynblat in view of Tsukagoshi, because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

Independent claim 5, as amended, recites a combination including, for example, "wherein, when the mobile terminal sends a service request including the user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway

converts the user identifier to a temporary identifier.” Sheynblat fails to teach or suggest at least the above listed claim elements as recited in amended claim 5.

The Examiner concedes that “Sheynblat however does not explicitly teach converts a user identifier of the mobile terminal to a temporary identifier” (Office Action at 4). However, the Examiner alleges that “Tsukagoshi explicitly teaches converts a user identifier of the mobile terminal to a temporary identifier (col.1, line 67-col.2, line 3).” (Office Action at 4). Applicants respectfully disagree.

Tsukagoshi, in col.1, line 67-col.2, line 3, explicitly states that “[t]he first home memory station changes the first temporary identifier to a second temporary identifier in response to the predetermined signal received from the mobile station.” (emphasis added.) However, Tsukagoshi’s teaching of changing two temporary identifiers does not constitute “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited by the amended claim 5 (emphasis added).

Moreover, in Tsukagoshi, “the mobile terminal MT transmits . . . to the home memory station 302 of the common carrier B through the nearby base station.” Tsukagoshi, column 4, lines 51-55, emphasis added. Therefore, such memory station in Tsukagoshi cannot constitute “the wireless gateway converts the user identifier to a temporary identifier,” as recited by the amended claim 5 (emphasis added).

Therefore, for at least the reason that neither Sheynblat nor Tsukagoshi, taken alone or in combination, teaches or suggests each and every element recited by claim 5, no *prima facie* case of obviousness has been established with respect to claim 5.

Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 5. Because claims 9-11 depend from independent claim 5, Applicants also request withdrawal of the Section 103(a) rejection of claims 9-11 for at least the same reasons stated above.

Further, independent claim 14, as amended, while of different scope, recites similar elements to independent claim 5. Claim 14 is therefore also allowable for at least the same reasons stated above. Applicants respectfully request withdrawal of the Section 1039a) rejection of claim 14 and its dependent claims 5 and 16.

III. Regarding the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of Tsudik

Applicants respectfully traverse the Examiner's rejection of claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi and Tsudik, because a *prima facie* case of obviousness has not been established with respect to these claims. Claims 7 and 8 depend from claim 5.

As set forth above, Sheynblat and Tsukagoshi fail to teach or suggest at least “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited in amended claim 5 and required by claims 7 and 8.

Tsudik fails to cure the deficiencies of Sheynblat and Tsukagoshi. The Examiner alleges that “Tsudik teaches two different identifier[s] being corresponded to each other(Abstract)” (Office Action at p. 6). Even assuming this allegation is true, which Applicants do not agree with, Tsudik fails to teach or suggest at least “wherein, when

the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited by the amended claim 5 and required by claims 7 and 8 (emphasis added).

Therefore, none of Sheynblat, Tsukagoshi, and Tsudik, taken alone or in combination, teach or suggest each and every element of Applicants’ invention as recited in claim 5 and required by claims 7 and 8. For at least this reason, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 7 and 8.

IV. Regarding the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of Fingerhut

Applicants respectfully traverse the Examiner’s rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi and Fingerhut, because a *prima facie* case of obviousness has not been established with respect to this claim. Claim 12 depends from claim 5.

As set forth above, Sheynblat and Tsukagoshi fail to teach or suggest at least “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited in amended claim 5 and required by claim 12.

Fingerhut fails to cure the deficiencies of Sheynblat and Tsukagoshi. The Examiner alleges that “Fingerhut teaches a location independent service provider” (Office Action at p. 8). Even assuming this allegation is true, which Applicants do not

agree with, Fingerhut fails to teach or suggest at least “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited by the amended claim 5 and required by claim 12 (emphasis added).

Therefore, none of Sheynblat, Tsukagoshi, and Fingerhut, taken alone or in combination, teach or suggest each and every element of Applicants’ invention as recited in claim 5 and required by claim 12. For at least this reason, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 12.

V. IV. Regarding the rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, and further in view of Fingerhut and Markowitz

Applicants respectfully traverse the Examiner’s rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Sheynblat in view of Tsukagoshi, Fingerhut, and Markowitz, because a *prima facie* case of obviousness has not been established with respect to this claim. Claim 13 depends from claim 12, which depends from claim 5.

As set forth above, Sheynblat, Tsukagoshi, and Fingerhut fail to teach or suggest at least “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited in amended claim 5 and required by claim 12 and 13.

Markowitz fails to cure the deficiencies of Sheynblat, Tsukagoshi, and Fingerhut.

The Examiner alleges that “ Markowitz teach the service provider name” (Office Action at p. 9). Even assuming this allegation is true, which Applicants do not agree with, Markowitz fails to teach or suggest at least “wherein, when the mobile terminal sends a service request including a user identifier, the location information, and a parameter to the wireless gateway, the wireless gateway converts the user identifier to a temporary identifier,” as recited by the amended claim 5 and required by claim 12 and 13 (emphasis added).

Therefore, none of Sheynblat, Tsukagoshi, Fingerhut, and Markowitz, taken alone or in combination, teach or suggest each and every element of Applicants’ invention as recited in claim 5 and required by claim 12 and 13. For at least this reason, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 13.

VI. Regarding new claims 25-28

Applicants have added new claims 25-28 to address other aspects of the present invention. Support for claims 25-28 may be found at, for example, pages 18-20 of the specification. Because claims 25-28 depend from claim 5, claims 25-28 are also allowable for at least as being dependent from an allowable base claim.

In addition, Applicants respectfully submit that the Examiner’s applied references fail to teach, for example, “wherein the user identifier identifies the mobile station and the temporary identifier is unable to identify the mobile terminal without information on converting the user identifier to the temporary identifier,” as recited in claim 25; “wherein the service request identifier prevents the service provider from knowing either the user

identifier or the temporary identifier; and is used by the mobile gateway to identify the mobile station based on the temporary identifier and the communication control information," as recited in claim 26; "wherein the service request does not include either the user identifier or the temporary identifier," as recited in claim 27; or "wherein the temporary identifier is only used by the wireless gateway and the wireless gateway converts the user identifier to the temporary identifier without informing the mobile terminal the temporary identifier," as recited in claim 28.

VII. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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